

PATENT

Attorney Docket No.: 109846-137

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: DEKKER *et al.*

Art Unit: 1638

Appl. No.: 09/469,812

Examiner: Kruse, D.

Filed: December 22, 1999

For: PLASMIDS FOR PLANT  
TRANSFORMATION AND  
METHOD OF USING THE SAME

FAX RECEIVED

JUN - 7 2002

PETITIONS OFFICE

## CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to Mr. Steven Brantley, Esq. at the United States Patent and Trademark Office, Commissioner for Patents, at fax number 703-308-6916.

June 7, 2002  
Date of Transmission

Laura E. Blacker  
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Commissioner for Patents  
Washington, D.C. 20231  
BOX PETITION

**REQUEST FOR RECONSIDERATION OF A PETITION FOR  
SUSPENSION OF THE RULES UNDER 37 C.F.R. § 1.183**

Sir:

Applicants appeal the Dismissal Decision (hereinafter the "Decision") mailed April 8, 2002, relating to the April 28, 2001 Petition under 37 C.F.R. § 1.183 for waiver of rule 37 C.F.R. § 1.605(a). Applicants note the Petition is identified as having been filed on September 14, 2001, however Applicants' records indicate that the Petition was filed on August 28, 2001. A copy of the filing papers that includes a Certificate of Mailing and Facsimile transmission establishing the filing date as August 28, 2001 is attached herewith.

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Applicants submit to the Commissioner a Request For Reconsideration of A Petition for Suspension of the Rules relating to a non-statutory one-month time limit (hereinafter the "One Month Requirement") for the submission of a proposed claim for interference purposes (detailed in the Office Action dated March 28, 2001 (File Wrapper Paper Number 12)).

Applicants thank Mr. Stephen Brantley of the Petitions Office for the telephonic interview in April 2002, during which it became clear to Applicants' representative that the Petition submitted on August 28, 2001 did not adequately articulate Applicants' position and reasons for deserving a waiver of 37 C.F.R. § 1.605.

#### The Applicable Law

The Decision indicates that for a grant of a petition under 37 C.F.R. § 1.183 to be appropriate "petitioner must demonstrate the existence of an extraordinary situation where justice requires waiver of one or more federal regulations." (Decision, April 8, 2002, Paper No. 19, page 1). The Decision clearly details the applicable law in that 37 C.F.R. § 1.605(a) and M.P.E.P. § 2305 when read together require that Applicants amend the application to present the suggested claim verbatim. The Decision citing 37 C.F.R. § 1.605(a) further states that "...petitioner must submit the suggested claim within the timer period set by the examiner." (*Id.*, page 3) (Emphasis added).

The March 28, 2001 Office Action indicated that the suggested claim should be submitted within one month or 30 days from the mailing date of the Office Action. Additionally, it stated that failure to make the submission would be considered a disclaimer of the subject matter (37 C.F.R. § 1.605(a)) and the provisions of 37 C.F.R. § 1.136(a) relating to extensions of time for response were not applicable.

#### The Decision Ruling

The Decision allegedly summarizes Applicants' position by stating that Applicants assert that an ambiguity in providing a response to the One Month Requirement existed. The Decision concludes by stating

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"it is unnecessary to address the above issue in so far as the suggested claim was not submitted by petitioner within either the one month period or the three month extendable time period. As of February 25, 2002, the suggested claim has not been submitted by applicant."  
(Decision, April 8, 2002, Paper No. 19, page 3)

The Decision further concludes "Petitioner had the capability to file the suggested claim, but chose not to file the claim. Petitioner's conduct does not justify waiver of 37 C.F.R. § 1.183." (*Id.*, page 4)

Applicants assert that a decision not to file the claim was not made. Rather, as explained in detail below, lapse of the One Month Requirement is attributable to extraordinary circumstances beyond Applicants' control, and Applicants were barred from submitting the claim after acquiring knowledge of the One Month Requirement.

**Applicants' Opportunity To Timely Submit The Required Claim Was Foreclosed By Extraordinary Circumstances Beyond Applicants' Control**

Applicants were disadvantaged in making a timely response to the One Month Requirement by a change in representation before the U.S. Patent and Trademark Office (U.S.P.T.O.) during the critical time period in question.

Applicants' lack of knowledge with respect to the one month time period for the submission of the recommended claim was due to the fact that Applicants changed representation before the U.S.P.T.O. approximately the same time that the March 28, 2001 Office Action was mailed. This change in representation prevented Applicants from timely responding to the One Month Requirement, since the amount of time required to transfer files and mail between representatives and time required to enter Applicants' application and patent portfolio data into the new representative's docketing system exceeded the extremely short One Month Requirement to submit the claim.

Applicants respectfully request that the Commissioner favorably reconsider this Petition in view of Applicants' misfortune of having the contemporaneous occurrence

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of a change in representation, with all of the normal complications associated therewith, with the unusual and extremely short response period of the One Month Requirement.

Applicants Were Barred From Submitting The Claim After Expiration of the One Month Requirement

It is respectfully asserted that Applicants did not make a decision not to file the required claim, since the One Month Requirement for response had lapsed prior to Applicants becoming cognizant of the requirement. Applicants did not submit the claim at a later date because, as indicated *supra*, an amendment of the application to enter the proposed claim must have been made within the time period set by the Examiner, *i.e.*, the One Month Requirement, and that time period had passed.

Thus, the claim was not submitted at any time after expiration of the One Month Requirement because 37 C.F.R. § 1.605(a) requires that the proposed claim be submitted by the non-extendible deadline provided by the Examiner, and, therefore, it was not possible to do so. Rather, Applicants believed that the appropriate course of action was (1) to petition for a waiver of the One Month Response requirement and, upon grant of the petition, (2) to file the amendment entering the required claim into the application.

Applicants Acted Diligently Without Negligence

The Decision indicates that the Office may consider circumstances when courts have exercised their equitable powers to waive requirements of a statute or regulation, and it cites several court decisions that go to the issues of due diligence and/or negligence. For example, the Decision cites Goetz & Goetz v. Secretary of Health and Human Services, 2001 U.S. App. LEXIS 943, 5 (Fed. Cir. 2001) as standing for the proposition that lack of due diligence precludes the application of equitable tolling, and it cites Taliani v. Chrans, 189 F.3d 1269, 1272 (11<sup>th</sup> Cir. 1999) (*per curiam*) as standing for the proposition that a lawyer's miscalculation of a limitations period is not a valid basis for equitable tolling.

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Applicants aver that the instant situation is distinguishable over such decisions. First, Applicants acted diligently to resolve the instant situation. As per the reasons described *supra*, Applicants were disadvantaged by a change in representation that prevented them from being notified of the One Month Requirement. Once discovered, Applicants did not believe it was possible to submit the required claim until a petition had been granted tolling the One Month Requirement. Applicants' representative contacted and sought the advice of Examiner David Kruse and Examiner Michael Woodward within the allowable and extendible time period for response to the outstanding Office Action. Thus, Applicants acted diligently in pursuing their right to the subject matter of the proposed claim.

Second, the instant situation is not the result of a miscalculation or misinterpretation of the applicable rules. Applicants understood the One Month Requirement to be set by the Examiner in accordance with 37 C.F.R. § 1.605(a). If it were not for Applicants' misfortune of having the March 28, 2001 Office Action mailed at the time representation before that U.S.P.T.O. was changed, Applicants would not be in this situation, since the One Month Requirement would have been identified within the time period set for response.

Justice Requires Waiver Of 37 C.F.R. § 1.605(a)

Applicants assert that an extraordinary set of circumstances lead to Applicants' loss of right to the subject matter of the claim proposed by the Examiner. Furthermore, Applicants' loss of the right to claim this subject matter is unrelated to patentability, and Applicants' failure to respond within the One Month Requirement cannot be viewed as an admission related to prior art.

Therefore, it is respectfully submitted that it is unjustifiable not to allow Applicants to claim the subject matter of the claim proposed in the March 28, 2001 Office Action. Given the unusual circumstances that prevented Applicants from submitting the claim, namely the mailing of the March 28, 2001 Office Action contemporaneous with the transfer of Applicants' case from one representative to another, the most equitable solution is the granting of this petition.

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**CONCLUSION**

Applicants believe that sufficient bases for the granting of this Petition have been provided in the statements provided herein. Under these circumstances, Applicants aver that surrendering of the subject matter of the suggested claim for interference purposes due to a lack of a timely filed response under the circumstances described above is not fair and proper.

Applicants respectfully request favorable consideration of this Petition and the opportunity to be fully responsive to the March 28, 2001 Office Action.

Respectfully submitted,

HALE AND DORR L.L.P.

Date:

June 7, 2002

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